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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,372	05/04/2007	Susanne Birkel	3829	6036

278 7590 03/26/2010  
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103 EAST NECK ROAD  
HUNTINGTON, NY 11743

EXAMINER
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YU, GINA C

ART UNIT	PAPER NUMBER
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1611

NOTIFICATION DATE	DELIVERY MODE
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03/26/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

striker@strikerlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,372	<b>Applicant(s)</b> BIRKEL ET AL.	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10 and 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>October 30, 2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 4-6, 10, 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 15, 2010.

Applicant has elected a) hydroxypropylcellulose as the species of viscosity-modifying substance; b) vinyl acetate/crotonic acid copolymers as species of hair-care or hair-setting substance; c) phenyl-trimethicone as species of silicone compound, and d) PEG-40 hydrogenated castor oil as species of surfactant.

The traversal is on the ground(s) that the present application is a national stage entry under 35 U.S.C. 371, and therefore a restriction/election requirement under 35 U.S.C. 112 would not be proper. Examiner views the requirement is still deemed proper even under the unity of invention standard. In this case, the active ingredients or additives of instant claim 1 (B) do not share common utility or a substantial structural feature essential to that utility, if there is any. The utilities of viscosity modifiers, hair care substance, silicone compounds, photoprotective substance, preservatives, soluble dyes, etc., are all distinct and unique to the each of the components. Furthermore, as indicated in the rejection below, the combination of the terpolymer of claim 1(A) and at least one of the components of claim 1(B) lacks novelty; since the invention claimed in a generic or linking claim lacks novelty, the inventions as claimed as whole lack common inventive concept. Thus, the species election requirement is still proper in this case.

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Claims 1-3, 7-9, 11-19 read on the elected species and have been examined on the merits.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 2, line 20, the disclosed tradename of VP/methacrylamide/vinyl imidazole copolymer appears to be incorrect. The correct name appears to be Luviset® Clear (BASF, CAS N 38139 – 93 – 4), not “Luviflex® Clear”. See, for example, applicant's submission SOEFW-JOURNAL, 12-2003, the translated abstract. Appropriate correction is required.

### ***Claim Objections***

Claims are objected to because of the following informalities: The amendment filed on August 15, 2006 is handwritten. Title 37 C.F.R. 1.52 provides:

#### **§ 1.52 Language, paper, writing, margins, compact disc specifications.**

(a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding .

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

- (i) Flexible, strong, smooth, non-shiny, durable, and white;
- (ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1

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inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

**(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and**

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 11, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by HÖSSEL et al., “VP/Methacrylamide/Vinyl Imidazole Copolymer: A New Standard for Hairstyling”, SÖFW-Journal, 129 Jahrgang 12-2003 (“Hössel” hereunder).**

Hössel discloses a hair-treatment formulation comprising VP/methacrylamide/vinylimidazole copolymer, the terpolymer of instant claim 1 (A), and

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PEG-40 hydrogenated castor oil (applicant's elected surfactant), see p. 70, Haargel für sehr starken Halt. See instant claim 1. The hair gel is said to have viscosity of 30500 mPas, meeting instant claim 15. The reference also discloses a spray formulation and aerosol foaming products comprising propane and butane. See page 70, Pumpspray VOC 55; pages 70 and 71, Haarschaum mit Luviset Clear; instant claims 17 and 18.

**Claims 1, 2, 11, 12, 15, 17, 18 are rejected under 35 U.S.C. 102(a) as being anticipated by NGUYEN-KIM et al. (WO 03/092640 A2) ("Nguyen-Kim" hereunder).**

Nguyen-Kim discloses the use of VP/methacrylamide/vinylimidazole copolymer, the terpolymer of instant claim 1 (A) in hair styling products. See English equivalent, US 2005/0175572 A1. The reference discloses in Examples 1) and 2), viscous, solid hair gel comprising the terpolymer (50 % active) in the amount of 10 % by weight of the composition and Carbopol 940 (1% active, crosslinked polyacrylate polymer) in the amount of 30 %, which anticipates instant claims 1, 2, and 15. See English equivalent, paragraphs [0288-0290], Examples No 1-50 and 51-100. The reference indicates the viscosity of the gel-like compositions is in a range of 600-60,000 mPas. See [0037]. Instant claims 1 and 2 are also anticipated by Example 3), which illustrates the terpolymer present in 5 % by weight (30 % active) with 25 % by weight of hydroxyethylcellulose (2% active). See paragraph [0292]. Pump spray formulations as presently claims in instant claim 17 are disclosed in examples 5) and 6). The foamable product of instant claim 18 is disclosed in example 7).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3, 7-9, 13, 14, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over NGUYEN-KIM et al. (WO 03/092640 A2) as applied to claims 1, 2, 11, 12, 15, 17, 18 as above, and further in view of the reference.**

Nguyen-Kim is relied upon as discussed above. The reference further teaches the terpolymer is useful for hair and skin cosmetic products as a water-soluble film-forming polymer which form "smooth, tack-free films" giving the hair and the skin "a pleasant feel and good conditioning effect or setting action". See [0002-0005].

The illustrated formulations do not disclose the components of the instant claims 3, 7-9, 13, 14, 16, and 19 with sufficient specificity.

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The components of the instant claims are taught in the reference as suitable cosmetic carrier or additives for formulation with the VP/methacrylamide/vinylimidazole copolymer. The cosmetically acceptable carriers may be a silicone oil, such as linear polydimethylsiloxanes, for example. See [0183]; instant claim 7. Using at least one cosmetically or pharmaceutically acceptable polymer different from the terpolymer, such as copolymers of vinyl acetate and crotonic acid (elect viscosity modifier), is also suggested in [0193-0194]. See instant claim 2.

Although the hair gel in Example 2) contains benzophenone-4, the reference further teaches in paragraph [0192] that p-aminobenzoates, cinnamates can be also used, rendering the sunscreens of instant claim 8 obvious. Also mentioned in the same paragraph is the utility of minerals and metal oxides titanium dioxide and zinc oxide as UV blocking pigments, rendering instant claims 13 and 14 obvious.

The prior art does not use the term "hair wax" as in instant claim 19, however, the reference teaches using waxes in the oil phase of the cosmetic composition which may be in the form of ointment or paste. See [0184],[0188].

Also disclosed in the reference is a skin cosmetic in the form of O/W cream, comprising VP/methacrylamide/vinylimidazole copolymer, paraffin oil (instant claim 9) and methyl paraben and propyl paraben (para 4-hydroxy benzoate, instant claim 12). Although the formulation lacks the surfactants of instant claim 11, the reference teaches in paragraph [0217-0220] that mono- and diesters of C12-C18 fatty acids and polyglycerol, or condensates of ethylene oxide and propylene glycol, rendering the polyglyceryl fatty acid esters and addition products of ethylene oxide and propylene



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oxide of the instant claim obvious. Since the present claims are directed to cosmetically applicable composition and the recited term "hair-treatment" in claim 1, line 1, does not add any structural limitation to the claimed subject matter, the term is a preamble which denotes the intended future use of the composition. The prior art skin cream is capable of application to hair, and meets instant claim limitations.

In this case, Nguyen-Kim teaches specific examples comprising VP/methacrylamide/vinylimidazole copolymer in hair or skin cosmetic compositions which form smooth, tack-free films for pleasant feel and conditioning effects. Since the reference also teaches and suggests suitable cosmetic carriers and/or additives for further formulation, it would only take ordinary skill in cosmetic art to modify, with a reasonable expectation of success, the teachings of the reference to make various cosmetic compositions that impart the advantageous film-forming properties of the prior art terpolymer. Since the reference teaches the functions of the cosmetic ingredients that are recited in the instant claims, for example, silicone oils as a carrier or metal oxides as UV filters, the skilled artisan would have been obviously motivated to make cosmetic compositions of such specific utilities from the disclosed cosmetic ingredients.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/  
Primary Examiner, Art Unit 1611